

**BRIEF FOR APPELLEE-DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2007-1221
(Interference No. 105,455)

IN RE HAROLD R. GARNER,
Appellant.

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

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STATEMENT OF RELATED CASES

The Director is not aware of any other appeal from the Board of Patent Appeals and Interferences (“Board”) for the United States Patent and Trademark Office (“USPTO”) in connection with this application that has previously been before this or any other court. The Director is also unaware of any other case pending in this or any other court that will directly affect, or be directly affected by, this Court’s decision in the pending appeal.

**BRIEF FOR APPELLEE-DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2007-1221
(Interference No. 105,455)

IN RE HAROLD R. GARNER,
Appellant.

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

I. STATEMENT OF THE ISSUE

There are two issues on appeal, both of which result from Garner's failure to cite sufficient evidence in his request to provoke an interference with Quate's patent. First, whether the Board properly exercised its discretion under 37 C.F.R. § 41.202(d)(2) to refuse to consider, without a showing of good cause, evidence Garner relied on only after the Board issued an order to Garner to show why judgment should not be issued against him. Second, given the evidence properly before the Board, whether the Board correctly determined that Garner had failed to establish priority over Quate's patent sufficiently to avoid judgment against him.

II. STATEMENT OF THE CASE

This appeal arises from a two-party interference involving priority of inventorship as to a single Count. The main issue is a dispute over the Board's application of 37 C.F.R. § 41.202(d)(2) ("Rule 202(d)") to preclude Garner from relying on declarations and exhibits which he omitted from his initial filing suggesting the interference.

III. STATEMENT OF THE FACTS

A. The Parties and the Count

The interference involved U.S. Patent No. 6,480,324, issued to Calvin F. Quate and David Stern ("Quate's patent"),¹ and U.S. Application Serial No. 09/998,341 filed by Harold R. Garner ("Garner's application"). JA0005; JA0190-193.² Quate was the senior party, based on his patent application's earlier effective filing date. Id. The Quate patent issued from an application filed June 14, 2001. JA0031; JA0192. Through a divisional application, Quate's patent claims priority back to a provisional application filed May 29, 1998. JA0031. Garner was the junior party, based on his application's later effective filing date. JA0192. Garner's current application was filed November 29, 2001. Id. Garner's

¹ On May 16, 2007, the Court granted Quate's motion to strike its designation as the Appellee, and granted the Director's motion to participate in the appeal.

² Citations to Appellant's Brief will be referred to as "Br. at ___" and citations to the Joint Appendix as "JA___".

application claims priority through two continuing applications to a provisional application filed June 4, 1998.³ JA0086; JA0193.

Garner, as the junior party, had the burden of establishing prior inventorship. 37 C.F.R. § 41.202(d). Garner attempted to establish priority by showing that he actually reduced an invention within the proposed count to practice before Quate's effective filing date. JA0017-18.

The count Garner suggested is based on claim 39 of Garner's application, as it existed before it was amended on May 14, 2004, which read:

39. An apparatus for catalyzing a reaction on a substrate, comprising:

a light source;

a computer-controlled micromirror positioned to redirect light from the light source toward the substrate; and

a reaction chamber, wherein light redirected by the micromirror catalyzes a chemical reaction proximate the substrate in the reaction.

JA0017; JA0143.

B. Before the Examiner

During prosecution of his application, the examiner rejected Garner's claims as anticipated by Quate's patent. JA0133. In response, Garner attempted to force

³ On February 12, 2007, Garner filed U.S. Application Serial No. 11/704,536 also claiming priority back to his provisional application, 60/087,948.

Quate's issued patent into an interference proceeding. JA0130-139. To that end, Garner amended his claims to correspond to those in Quate's patent. JA0130-139. He also offered arguments to explain how his submission met all of the requirements of Rule 202(d) for provoking an interference with an issued patent.

Id.

In particular, Garner submitted a declaration he executed on November 28, 2001 in the parent application ("2001 Garner declaration").⁴ JA0113-0114. Garner had already filed this declaration under 37 C.F.R. § 1.131 to overcome a prior art rejection. JA0005. The 2001 Garner declaration included: i) photographs of a device he allegedly built before the filing date of that prior art reference; and ii) lab notebook pages that he alleged showed that the device worked. JA0005; JA0179-189. To corroborate his claim that he had built the device depicted in his photograph, Garner also relied on a one-page declaration of John Fondon, executed on October 20, 2005 ("2005 Fondon declaration"). JA0138. The 2005 Fondon declaration references the photograph and states simply that Fondon "saw" the device depicted in 1997. JA0139. In his initial Rule 202(d) submission, Garner claimed that the two declarations and their exhibits provided sufficient evidence to

⁴ The Board noted that a declaration Garner filed on March 1, 2001 was "not in evidence." JA0020.

justify forcing Quate's patent into an interference proceeding. JA0130; JA0134-135.

The examiner sent Garner a letter instructing Garner that his 2001 declaration was "insufficient" to provoke an interference under Rule 202(d). JA0007; JA0142. In that letter, he invited Garner to submit a second declaration that complied with the requirements of Rule 202(d). JA0007. Specifically, the examiner instructed Garner that, "A [d]eclaration under C.F.R. § 202(d)(2) with appropriate signature is required."

In response, Garner revised his declaration, re-executed it on December 8, 2005 ("2005 Garner declaration," JA0166-167), and filed it on January 26, 2006. JA0007. To use Garner's own words, he merely "retitled the previously submitted § 1.131 declaration as a Rule 202(d) declaration and resubmitted [it] without substantive change." Br. at 9; JA0007; JA0142. In support, Garner resubmitted the Fondon 2005 declaration without change. JA0007. With that, the examiner forwarded Garner's request to provoke an interference to the Board. JA0007.

C. Before the Board

1. The Board's Declaration of Interference and Order to Show Cause

The Board found Garner's Rule 202(d) showing insufficient to establish priority over Quate's patent. JA0140-151. The Board considered the 2001 Garner

declaration, the 2005 Garner declaration and the 2005 Fondon declaration.

JA0146-150. Specifically, the Board found that the declarations Garner relied on failed to prove: i) “that a device comprising each of the elements set forth in the proposed count was operated or tested,” and ii) that the device “actually worked for its intended purpose.” JA0147.

Per Rule 202(d)(2), the Board declared an interference and placed Garner under an order to show cause why judgment should not be entered against him. JA0140-151. The Board simultaneously issued an order reminding Garner that Rule 202(d) prohibited him from submitting “new evidence in support of priority” unless Garner was able to show “good cause” for the untimely submission. 37 C.F.R. § 41.202(d)(2); JA0152-153. The Board invited Garner to “submit arguments [to explain] why good cause might exist for Garner to submit new evidence to demonstrate priority,” should Garner seek to submit such evidence. JA0152.

2. Garner’s Response

In response to the Board’s Order to Show Cause, Garner relied on five pieces of evidence. JA0154-165. In particular, Garner cited to the 2005 Garner declaration and the 2005 Fondon declaration, both of which Garner had submitted and relied on in his Rule 202(d) filing. JA0005; JA0013-15; JA0155.

Additionally, Garner's response referenced three documents that he did not submit in his original Rule 202(d) filing to show priority. JA0154-165. The three newly referenced documents were: i) a declaration by Garner under 37 C.F.R. § 1.131, originally filed on September 2, 2003, to overcome a prior art rejection ("2003 Garner declaration"); ii) the specification of his provisional application; and iii) the specification of his utility application. JA0013-14; JA0154-55. Although warned against citing documents to the Board for the first time in his response without a showing of good cause (JA0152-53), Garner did not attempt to explain his belated reliance on these documents. JA0016.

3. The Board's Decision

The Board issued judgment against Garner. JA0001-03. In its decision, the Board noted that "Garner [did] not challenge the findings of the show cause order" in which the Board had found Garner's originally submitted evidence inadequate to show priority. JA0007. Based on the evidence properly before it, the Board confirmed that Garner had failed to show priority. JA0017-25.

The Board had no objection to Garner's reliance on evidence he cited and relied on in his original filing. JA0014-15. Specifically, because Garner had filed both the 2005 Garner Declaration and the 2005 Fondon declaration as part of his Rule 202(d) filing, the Board considered these documents. JA0014-15. The Board found, however, that: i) Garner had failed to cite the remaining three

documents in his original Rule 202(d) filing, and ii) that Garner had not attempted to show good cause for his belated reliance. JA0013-16. Thus, citing Rule 202(d), the Board refused to consider Garner's new arguments based on evidence he relied on for the first time in his response to the Board's Show Cause Order. JA0016.

In support of its ruling, the Board offered a detailed analysis of the history of Rule 202(d) and the precedent confirming its application. JA0008-13. The Board quoted the language of Kistler v. Weber, 412 F.2d 280, 285 (CCPA 1969), in which this Court's predecessor noted that the "expense" and "special hardships" that a protracted interference "works on a patent" were the "laudable purposes" behind the rule's requirement that the applicant "prove (prior to a 'full hearing') by way of affidavits and documentary evidence that he is at least prima facie entitled to an award of priority" JA0009. The Board explained that the regulation was promulgated to, among other things, "manage a process more efficiently, limit patentee exposure to harassment, and reduce overall pendency of interferences . . . with concomitant patent term extension." JA0010.

The Board also noted that in Hahn v. Wong, 892 F.2d 1028 (Fed. Cir. 1989), this Court recognized the need for such a rule and approved of the Board's application of it to exclude evidence relied on for the first time in response to a show cause order. JA0010; JA0012. In that case, the Court observed that the rule was revised to "tighten" the initial showing requirements and encourage more

comprehensive initial filings, because that was in the best interests of the public.

JA0010. The Board also quoted from comments accompanying the publication of Rule 617—the predecessor to Rule 202(d)—in which the USPTO explained that previous abuses by practitioners mandated limiting submissions of evidence after the required initial filing:

Under current practice (37 CFR 1.228), additional evidence may be submitted with a response to an order to show cause “when a showing in excuse of their [its] omission from the original” showing is made. The “good cause” showing proposed in § 1.617(b) would impose a stricter standard. The stricter standard is believed to be necessary to encourage applicants copying claims from a patent to better prepare their initial showings under proposed § 1.608(b). Under current practice, the Board of Patent Interferences has found that substantial time is lost in issuing orders to show cause based on an inadequate initial showing only to have an adequate showing made with the response to the order to show cause[.]

JA0009-10 (quoting from Notice of Proposed Rulemaking, Patent Interference Proceedings, 49 Fed. Reg. 3768, 3775 (January 30, 1984)). Given the precedent, and history of the rule, the Board confirmed that the time and place for submitting the evidence a party relies on to show priority “is . . . the 202(d)(1) submission.”

JA0016. It concluded that to consider Garner’s untimely cited evidence would frustrate the rule’s purpose. Id.

Considering only the evidence properly before it, the Board ruled that Garner had not shown prima facie entitlement to priority. JA0017-0025. The Board found that Garner’s declarations and supporting exhibits failed to explain:

i) that the device depicted in the photograph contained all of the features recited in the count or, ii) how the device depicted operated, much less whether it operated in the manner required by the count: JA0022-23. Accordingly, the Board issued judgment against Garner. JA0001-3.

IV. SUMMARY OF THE ARGUMENT

To justify forcing an issued patent into an interference proceeding, an applicant must present sufficient evidence that, if unrebutted, entitles applicant to priority over the patent. 37 C.F.R. §§ 41.202(d)(1) & 41.202(e). Through Rule 202(d), the Board warned that if an applicant's evidence is inadequate to show priority, it may issue an order to show cause why judgment should not issue against the applicant. Any "[n]ew evidence in support of priority will not be admitted except on a showing of good cause." 37 C.F.R. § 41.202(d)(2).

The plain language of the regulation instructs applicants to file their evidence "in support of priority" in their initial Rule 202(d) filing, and prohibits untimely submissions of "new evidence in support of priority" where the delay in submitting the new evidence is unjustified. This Court's precedent makes it clear that rule confers on the Board the discretion to exclude evidence that applicants could have submitted in their initial Rule 202(d) filing, but did not.

The Board correctly applied the rule to Garner's new evidence which he belatedly offered to compensate for a deficient initial showing. While Garner

knew that he was required “to make a prima facie showing that he invented the claimed device” before the effective date of Quate’s patent (JA0017), he relied solely on the 2005 Garner declaration, the Fondon declaration, and their supporting exhibits. This is the case even after the examiner gave him a second chance to submit additional evidence to show priority. But as the Board correctly found, these two declarations failed to substantiate multiple facts critical to proving that Garner had reduced the invention to practice in August 1997, as Garner alleged.

The declarations fail to explain how the photographs and notebook pages show that all of the elements of the proposed count were present in the device illustrated, or that the device worked in the manner required by the count. In fact, in his declarations, Garner made no effort to explain how the contents of those exhibits established that the device depicted in the photographs worked for the intended purpose. As a result, the Board properly rendered judgment against Garner.

In formulating a challenge to the Board’s decision, Garner misinterprets Rule 202(d). Garner argues that the regulation should be interpreted as prohibiting the late filing of newly created evidence only, not evidence that “already existed” and could be found in his application file. That interpretation, however, conflicts with: i) the plain language of Rule 202(d), ii) this Court’s precedent affirming the

Board's interpretation of the rule and, iii) the policy behind it, as explained in the rule histories.

V. ARGUMENT

A. Standard of Review

The Court reviews "Board decisions pursuant to the permissive rules governing patent interference proceedings for abuse of discretion." In re Sullivan, 362 F.3d 1324, 1326 (Fed. Cir. 2004) (citing Eli Lilly Co. v. Bd. of Regents of the Univ. of Wash., 334 F.3d 1264, 1266 (Fed. Cir. 2003)). This Court must confer "substantial deference" upon "an agency's interpretation of its own regulations." Thomas Jefferson Univ. v. Shalala, 512 U.S. 504, 512 (1994); Star Fruits S.N.C. v. United States, 393 F.3d 1277, 1282 (Fed. Cir. 2005). Thus, the USPTO's interpretation and application of its regulations must be accepted unless "plainly erroneous or inconsistent with regulation." Auer v. Robbins, 519 U.S. 452, 461 (1997) (quoting Bowles v. Seminole Rock & Sand Co., 325 U.S. 410, 414 (1945)); see also, Star Fruits, 393 F.3d at 1282.

Priority of invention and reduction to practice are questions of law that are based on subsidiary factual findings. Eaton v. Evans, 204 F.3d 1094, 1097 (Fed. Cir. 2000); Cooper v. Goldfarb, 154 F.3d 1321, 1327 (Fed. Cir. 1998). This Court affirms the Board's factual determinations if they are supported by substantial evidence and reviews the Board's legal conclusions de novo. Hitzeman v. Rutter,

243 F.3d 1345, 1353-54 (Fed. Cir. 2001); In re Gartside, 203 F.3d 1305, 1316 (Fed. Cir. 2000).

B. The Board Properly Exercised Its Discretion Under 37 C.F.R. § 41.202(d)(2) to Refuse to Consider Garner's New Evidence

In his initial Rule 202(d) filings, Garner relied on two extremely abbreviated declarations to explain the two exhibits he argued substantiated his claim of priority over Quate's patent. Only after the Board issued a show cause order against him did Garner offer the 2003 Garner declaration, and remaining documents, in support of his claim for priority. In refusing to consider Garner's newly cited documents, the Board properly applied Rule 202(d).

At the time Garner offered his Rule 202(d) submission, Garner was aware that to provoke an interference with Quate's patent he was required "to make a prima facie case of why [Garner] will prevail." JA0134. Specifically, under 37 C.F.R. § 41.202(e), an applicant is required to make a showing that "if unrebutted, support[s] a determination of priority" in the applicant's favor. Nevertheless, in his first attempt at a Rule 202(d) submission, he relied solely on the 2001 Garner declaration, the 2005 Fondon declaration, and supporting exhibits. JA005; JA0013-15. When the examiner informed him that his showing was insufficient and gave him a second chance to submit evidence to show priority (JA0007), he

did not take that opportunity to submit his new evidence. Instead, he merely resubmitted the same evidence.⁵ JA0007.

The Board found the evidence in Garner's Rule 202(d) filing insufficient to show prima facie entitlement to priority. JA0140-151. Specifically, those two declarations lacked an explanation of: i) where all of the elements of the count are found in the device shown in the exhibits, and ii) operation of the device as required by the count. JA0022-25. In accordance with Rule 202(d), the Board declared the interference, issued a show cause order, and issued an order reminding Garner that "new evidence" in support of priority would not be considered absent a showing of good cause. JA0007. In that "new evidence" order, the Board contrasted the submission of "new" evidence from "previously-submitted" evidence. JA0152-153. Thus, the Board made it clear to Garner that, absent good cause, in his response he could not rely on anything he had not relied upon in his initial Rule 202(d) submissions.

Nevertheless, in response Garner relied on an additional three documents that Garner had not relied on or discussed in his initial Rule 202(d) filings. JA0154-165. The Board refused to consider those documents, citing Rule 202(d)'s prohibition against relying on "[n]ew evidence in support of priority." JA0008-16.

⁵ Garner retitled and reexecuted the 2001 Garner declaration as the 2005 Garner declaration. Br. at 9.

Specifically, the Board concluded that under Rule 202(d) to be considered “[t]he evidence must be within the 202(d)(1) submission, relied upon and discussed in the submission.” JA0016 (emphasis added). Consequently, the Board held that Garner’s reliance on the three new documents was improper. JA0016.

Moreover, in his response to the Board’s show cause order, Garner made no attempt to justify his belated reliance on this evidence, much less show “good cause” for his failure to earlier cite these documents. JA0016. Nor could he. All three documents existed and were available to him at the time of his Rule 202(d) filings. The Board correctly exercised its discretion not to consider evidence Garner cited to the Board for the first time in his response to the show cause order.

The Board’s decision refusing to consider Garner’s new evidence is entirely consistent with this Court’s precedent, including Hahn v. Wong, 892 F.2d 1028 (Fed. Cir. 1989) and Huston v. Ladner, 973 F.2d 1564 (Fed. Cir. 1992). Those opinions are particularly instructive given how strikingly similar the facts in those cases were to the present case.⁶ In Hahn, after the Board declared an interference and issued a show cause order, the applicant tried to submit additional affidavits to supplement his inadequate initial showing. 892 F.2d at 1031-32. To get around

⁶ The Board’s decision relied heavily on this Court’s opinions in Hahn and Huston. Garner chose not to mention Hahn in his brief, even though the Board’s decision refers to it by name in no less than six instances. Nor does Garner’s brief contain a single citation to Huston, which the Board also cited repeatedly.

the prohibition against relying on additional evidence, Hahn argued that his counsel's failure to appreciate the corroboration required for an adequate showing of reduction to practice, gave him "good cause" for not submitting those exhibits earlier. Id. at 1035. The Court found that the Board had not abused its discretion in refusing to permit Hahn to supplement his inadequate initial showing with material that Hahn "could and should have submitted with that initial submission." Id. at 1034-35 (emphasis added). Confirming the regulation, and the Board's application of it to Hahn's belated submissions, the Court observed that the regulation was implemented to tighten up initial-showing requirements and put an end to wasteful practices where applicant's make an "inadequate initial showing." Id.

Similarly, in Huston, the Board found the junior party's initial submission insufficient to show prima facie entitlement to priority and issued a show cause order. 973 F.2d at 1565. Huston responded with new evidence in the form of declarations on which Huston relied for the first time in response to the Board's show cause order. Id. The applicant attempted to justify his belated submissions of additional evidence by blaming his attorney. Id. at 1565. Huston claimed that his previous attorney had misrepresented his competence in interference matters and negligently filed an inadequate original submission. Id. Citing Hahn, the Court in Huston affirmed the Board's refusal to allow Huston to "supplement [his]

original showing” or consider Huston’s additional evidence. Id. at 1566-67. The Court noted that the evidence was not unavailable at the time applicant filed its request for an interference. Id.

As in Hahn and Huston, here the Board did not abuse its discretion in applying Rule 202(d) to exclude Garner’s untimely cited evidence. In some respects, the facts of this case are more egregious than those in Hahn or Huston. Here, Garner failed to cite declarations in his possession at the time of his Rule 202(d) filings, declarations he had earlier submitted in his own application file. Garner failed to rely on his 2003 declaration and other evidence even after the examiner instructed Garner to submit a second attempt to prove an interference, one compliant with Rule 202(d). Instead, Garner merely “retitled the previously submitted § 1.131 declaration as a § 41.202 declaration and resubmitted [it] without substantive change.” Br. at 9. Then, after the Board found that evidence inadequate, Garner cited new evidence to the Board without justifying his late citation of these documents, despite ample warning not to do so.

The issue of whether to consider an applicant’s untimely proffer is left to the discretion of the Board. Huston, 973 F.2d at 1567. In this case, as in Hahn and Huston, the Board did not abuse its discretion. Garner had the opportunity to cite the 2003 Garner declaration and other evidence in his Rule 202(d) filing, but failed to. The Board’s application of Rule 202(d) to bar Garner’s evidence is based on a

correct interpretation of that rule. Here, the Board's interpretation of Rule 202(d) is consistent with: i) the plain language of the rule, ii) this Court's precedent, and iii) the overall purpose of Rule 202.

1. To Force a Patent into an Interference, Applicants Must Make an Adequate Initial Showing of Priority Under 37 C.F.R. § 41.202(d)

A party seeking to provoke an interference with an issued patent cannot do so lightly. Specifically, Rule 202(d)(1) requires that an applicant seeking an interference with an issued patent, "must show why it would prevail on priority." In the very document Garner filed in an attempt to provoke an interference with Quate's patent, Garner acknowledged that:

§ 41.202(a)(4) requires the applicant to explain in detail why the applicant will prevail on priority. This is understood to be a similar requirement to the prior Rule 608, which requires the applicant to make a prima facie case of why it will prevail on priority, so that an interference will be declared.

JA0134 (emphases added). A showing is adequate "if unrebutted, [it would] support a determination of priority in favor of the party making the showing." § 41.202(e)(1).

2. Later Added "New Evidence in Support of Priority" Will Not Be Admitted Except on a Showing of Good Cause

By regulation, the USPTO has established a procedure for protecting patentees from baseless priority challenges by warning applicants to make an

adequate initial showing at the risk of an adverse judgment. § 41.202(d)(2). The Rule authorizes the Board to: i) declare an interference, ii) issue an order to the junior party to show why judgment should not be entered against it, iii) preclude submission of new evidence without “good cause,” and iv) enter judgment against the junior party if its evidence is insufficient to show priority. The rule states:

If an applicant fails to show priority under paragraph (d)(1) of this section, an administrative patent judge may nevertheless declare an interference to place the applicant under an order to show cause why judgment should not be entered against the applicant on priority. New evidence in support of priority will not be admitted except on a showing of good cause. The Board may authorize the filing of motions to redefine the interfering subject matter or to change the benefit accorded to the parties.

§ 41.202(d)(2) (emphases added). Thus, Rule 202(d)(2) makes clear that an applicant will not be allowed, after an inadequate initial showing, to submit new evidence without good cause.

3. “New Evidence in Support of Priority” Includes Any Evidence Not Relied on by Applicant in Their § 41.202(d)(2) Filing

In response to the Board’s show cause order, Garner relied on five documents. Three were cited for the first time in response to the show cause order. The Board found that those three were “new evidence in support of priority” under Rule 202(d) because they were not part of Garner’s earlier submissions to provoke an interference. Specifically, the Board held:

Rule 202(d) now focuses on the showing by itself, and the evidence contained therein, as the record for consideration in any show cause order. Anything else is “new” evidence, even if it is contained elsewhere in the PTO.

* * *

The time to show that one has sufficient evidence to prove one’s case is at the time of the 202(d)(1) submission. The place for one to do it is in the 202(d)(1) submission. The evidence must be within the 202(d)(1) submission, relied upon and discussed in the submission . . .

JA0013; JA0016 (emphases added). And in an order issued by the Board instructing Garner not to submit new evidence without first establishing good cause, the Board differentiated “new” evidence from “previously-submitted” evidence. JA0152-153 (emphasis added).

In interpreting Rule 202(d), the Board relied on: i) the plain language of the regulation, ii) the precedent of this Court, including Hahn and Huston, and iii) the regulatory histories of the rule as discussed in those cases. All three support the Board’s interpretation here. Moreover, the USPTO’s interpretation of its own rules is entitled to deference. In fact, the Court has stated that it will “accept the Board’s interpretation of Patent and Trademark Office regulations unless that interpretation is ‘plainly erroneous or inconsistent with the regulation.’” In re Sullivan, 362 F.3d 1324, 1326 (Fed. Cir. 2004) (citing Auer v. Robbins, 519 U.S. 452, 461-62 (1997), and Bowles v. Seminole Rock Sand Co., 325 U.S. 410, 414 (1945)).

In Stevens v. Tamai, 366 F.3d 1325, 1333 (Fed. Cir. 2004), the Court upheld a Board rule that imposed on parties to an interference, seeking to rely on a document to show priority, the burden of proving its content. Id. at 1333. The Court noted that in 35 U.S.C. § 2(b)(2)(A), “we understand Congress to have ‘delegated plenary authority over PTO practice, including interference proceedings,’ to the Office.” Id. Of particular relevance to this case, the Court held that, “[i]t seems appropriate to us that the Office can allocate the burdens associated with [the goal of just, speedy, and inexpensive determination of every interference] in a reasonable manner not inconsistent with the existing statutory scheme.” Id. Given that deference, and the substantial support underlying the Board’s interpretation here, the Board’s interpretation of Rule 202(d) should be affirmed.

a. The Plain Language of 37 C.F.R. § 41.202(d)(2) Compels the Board’s Interpretation of “New Evidence”

As noted, the Board interpreted the phrase “new evidence in support of priority” as any evidence not relied on by applicant in their Rule 202(d) submission. JA0013; JA0016. This interpretation of Rule 202(d) is consistent with the plain meaning of the language of the rule.

Under Rule 202(d), applicants attempting to provoke an interference must “show why [they] would prevail on priority.” The rule’s language presents an

unambiguous prohibition against submitting “new evidence in support of priority” without “good cause.” Given that unequivocal prohibition, it would be unreasonable to interpret the rule as suggesting applicants may rely, for the first time in their response to the show cause order, on available evidence that applicant failed to cite to the Board in their initial attempt to show priority.

b. The Court’s Precedent Expressly Supports the Board’s Rule on “New Evidence”

The Board’s application of Rule 202(d) is entirely consistent with the Court’s opinions in Hahn and Huston. In Hahn, affirming the Board’s decision the Court noted that the rules had been rewritten to provide the “stricter standard” requiring “good cause” to justify submitting new evidence. Id. at 1034. It deemed this tightening of the rules a “major change” from the previous standard that had been more lenient in allowing late submissions, while noting that the regulatory history explained the need for the change:

Under current practice, the Board of Patent Interferences has found that substantial time is lost in issuing orders to show cause based on an inadequate initial showing only to have an adequate showing made with the response to the order to show cause.” 49 Fed. Reg. at 48,423, 1050 Off. Gaz. Pat. Office at 392. The present case involves precisely that situation. The Board did not abuse its discretion in refusing to permit Hahn to supplement its inadequate initial showing with the material that it could and should have submitted with that initial submission.

Id. at 1035 (emphasis added). Thus, Hahn supports the Board's interpretation of the rule as excluding any evidence not cited and discussed in the applicant's Rule 202(d) submission.

Similarly, in Huston, 973 F.2d 1564, the Court confirmed the Board's exclusion of Huston's evidence, noting that Huston was unable to show that his "evidence was not available when the original showing was filed." Id. at 1566.

The Court approvingly noted that the rule was designed:

to ensure prompt resolution of patent interferences by encouraging applicants to prepare an original showing which is as complete as possible [and was] intended to reduce the time and expense for the parties and the Board by imposing a stricter standard for filing additional evidence after entry of an order to show cause is made. 49 Fed. Reg. 48416, 48423 (December 12, 1984), Off. Gaz. Pat. Office 385, 392 (Jan. 29, 1985).

Id. at 1566 (emphasis added). Thus, Huston also supports the Board's interpretation of Rule 202(d).

c. The Board's Interpretation of "New Evidence" Is Wholly Consistent with the Regulatory History of the Rule

The Board's interpretation of the rule is consistent with its purpose. The Board noted that the rule had been rewritten in 1984 to provide a stricter standard for applicants to supplement their initial prima facie showing. JA0009.

Specifically, the Board quoted comments accompanying the predecessor to Rule 202(d) which explained that the "good cause" standard for new evidence had been

added to enable the Board to: “manage a process more efficiently, limit patentee exposure to harassment, and reduce overall pendency of interferences . . . with concomitant patent term extension.” JA009-10 (citing 49 Fed. Reg. 3775); see also, Rules of Practice Before the Board of Patent Appeals and Interferences, 69 Fed. Reg. 49960, 49992 (August 12, 2004) (stating that “delay in making the [Rule 202(d)] showing would drag out the pendency of the interference.”). Were the Board to consider Garner’s belated evidence, it would frustrate “the PTO’s clearly stated purpose for the good cause requirement.”⁷ JA0016.

In Kistler v. Weber, 412 F.2d 280 (CCPA 1969), this Court’s predecessor explained that the rules served the “laudable purpose” of being a safeguard against the “notorious” expense and special hardships that a protracted interference “works on a patent.” Id. at 285. Rejecting the applicant’s argument that he should not have to prove prima facie entitlement to priority at this early stage of the proceeding, the Kistler Court concluded:

We cannot accept this procedural theory. To do so would entirely vitiate the purposes of [the rules requiring applicant make out a prima facie case of priority] and allow mere uncorroborated assertions to

⁷ This rule is consistent with the Court’s waiver doctrine applied against parties that wait until filing a request for reconsideration with the Board to submit new evidence or argument. See In re Nielson, 816 F.2d 1567, 1569 (Fed. Cir. 1987) (affirming the Board’s decision to treat as untimely applicant’s submission of evidence of nonobviousness with applicant’s request for reconsideration); In re Kroekel, 803 F.2d 705, 709 (Fed. Cir. 1986) (appellant waived an argument by waiting to raise it until his request for reconsideration before the Board).

take the place of proof of acts and circumstances adequate to overcome [the senior party's] filing date.

Id. at 288. And in promulgating Rule 202, the USPTO stated:

“Section 41.202(d)(2) restates Rule 617 by providing a basis for a summary proceeding on priority when the applicant fails to make a sufficient showing of priority. Under § 41.202(e), the showing must by itself, if unrebutted, warrant a determination of priority favorable to the applicant.”

69 Fed. Reg. at 49969 (emphasis added).

Moreover, practitioners have for decades interpreted these rules in a manner consistent with the Board's present interpretation. As early as 1985, following the implementation of the “stricter standards” of Rule 617 (predecessor to Rule 202(d)), commentators recognized that the new interference rules imposed a stricter standard regarding timely submission of evidence—to encourage applicants copying claims from a patent to better prepare their initial showings. See Francis A. Paintin, The Impact of the New Interference Rules on Chemical Patent Practice, 206 PLI/Pat 55, 70-72 (July 11, 1985). As one author put it:

Additional evidence in support of reduction to practice will be allowed only at the discretion of the Board, upon a showing of “good cause” for why the evidence was not submitted originally. The Federal Circuit has upheld Board decisions to prevent introduction of new evidence because: (1) an inventor's patent counsel “did not fully appreciate the kind of corroboration required to demonstrate a prima facie case for a complete reduction to practice”; and (2) an attorney misrepresented to a client his ability and experience in prosecuting interference cases.

R. Douglas Bradley, When Is Enough Enough? Reduction To Practice And Summary Judgment During Patent Priority Disputes, 72 Wash. L. Rev. 1109, 1131-1132 (1997) (citing Hahn v. Wong, 892 F.2d 1028, 1033-34 (Fed. Cir. 1989), and Huston v. Ladner, 973 F.2d 1564, 1567 (Fed. Cir. 1992)).

4. Garner's Arguments Do Not Show that the Board Erred or Abused Its Discretion

Garner argues that the Board's interpretation of Rule 202(d) is erroneous for no less than seven reasons. Specifically, Garner argues that the Board's interpretation of Rule 202(d) is wrong because: i) it excludes evidence in his application file; ii) it is inconsistent with previous definitions of the term "new evidence" issued by the Board; iii) it is in conflict with § 41.202(a)(5); iv) it is inconsistent with the "show cause" requirement of Rule 202(d); v) it is outdated, vi); it is inconsistent with earliest constructive reduction to practice rules; and vii) it is inconsistent with the manner in which other agencies define "new evidence."

First, Garner argues that "new evidence" does not include evidence in his application file. Br. at 23. Specifically, he argues that the rule cannot be read to prohibit new reliance on any evidence in his application file, even if not previously cited to the Board. In offering his interpretation, Garner improperly takes the term "new evidence" out of context by improperly reading out of the rule the language "in support of priority." See Lockheed Corp. v. Widnall, 113 F.3d 1225, 1227

(Fed. Cir. 1997) (requiring that the terms of the rule be read in context). As properly read, any document on which Garner newly relies to establish priority over Quate's patent in his proceeding before the Board is "new evidence in support of [Garner's claim to] priority," even if found in Garner's application.

Similarly, Garner repeatedly characterizes his excluded submissions as "evidence in the record." See e.g., Br. at 21. Garner is wrong. Documents found in Garner's application file are not "evidence in the record" before the Board if Garner did not properly submit them to the Board. JA0027-30 (listing the contents of the file for Interference No. 105,455). As the Board's September 15, 2006 order made clear, "new" evidence is anything other than evidence "previously-submitted" by Garner to prove priority. JA0152-153.

Second, Garner attempts to bolster his strained interpretation of "new evidence" by arguing that the Board previously defined that term in a manner inconsistent with its present definition. Br. at 30. In an order dated September 15, 2006, following the show cause order, the Board instructed Garner not to submit new evidence without first establishing "good cause." JA0152. In the body of the order, the Board differentiated "new" evidence from "previously-submitted" evidence in precisely the manner it did in its judgment. JA0152-153. In a footnote, the Board instructed Garner not to introduce any new evidence without first showing "good cause," giving as an example: "Any new testimony from any

witness for demonstrating priority of invention constitutes new evidence.”

JA0152. Garner argues that the language of the footnote is a different definition than the one the Board ultimately applied to his new evidence. Br. at 30.

Contrary to Garner’s suggestion, the language of the footnote is entirely consistent with the Board’s interpretation of “new evidence” and its subsequent decision to exclude Garner’s 2003 declaration and supporting exhibits. Declarations are written testimony. Thus, any “declaration” newly cited by an applicant to provoke an interference would qualify as “new testimony” in support of priority. And, as discussed above, in Hahn and Huston the Court affirmed the Board’s decision to exclude just such newly presented but available testimony.

The Board’s Standing Order, issued in all inter partes interferences, offers yet another example of the Board’s consistent interpretation of Rule 202(d). The Standing Order makes clear that documents from the application file, including the applicant’s specification, must be cited as an exhibit to become part of the record. Specifically, the order provides:

Records of the United States Patent and Trademark Office, including affidavits filed during examination, are not automatically part of the record before the Board. The first party seeking to rely on the record must submit a copy of the record as an exhibit.

JA0196; JA0247(Standing Order at ¶154.1.1., styled “Must be submitted as an exhibit”) (emphases added). The Board’s Standing Order further states: “If a

motion (or opposition or reply) relies on any document in the file of a patent or application (including a specification), the entire document must be made an exhibit in the contested case.” JA0247 (Standing Order at ¶154.1.2., styled “Reliance on a portion of a file”) (emphasis added).

Third, Garner argues that the Board’s interpretation of Rule 202(d) would cause a conflict with § 41.202(a)(5). Br. at 27-28. The two requirements are, however, unrelated. Section 41.202(a)(5) requires an applicant to show written description support for claims added or amended to provoke an interference by submitting a “claim chart.” The requirement is intended to protect patentees from applicants attempting to provoke an interference who do not have written description support for their invention but wish to, for example, simply attack the validity of another’s patent. See In re Spina, 975 F.2d 854 (Fed. Cir. 1992) (the USPTO should only declare an interference if the applicant had a right to claim the same subject matter). Unlike § 41.202(a)(5), § 41.202(d)(2) involves proffers of evidence to show actual reduction to practice. Moreover, as the Court’s holding in Falko-Gunter Falkner v. Inglis, 448 F.3d 1357, 1366 (Fed. Cir. 2006), makes clear, “the written description standard may be met (as it is here) even where actual reduction to practice of an invention is absent.” Id. at 1366. Contrary to Garner’s suggestion, the two sections are unrelated.

Fourth, Garner complains that the Board's interpretation of Rule 202(d) renders the "show cause" requirement of the rule meaningless. Br. at 29. In other words, Garner argues that under the Board's interpretation of Rule 202(d), an applicant cannot respond to the Board's show cause order without submitting new evidence.

Garner is mistaken. A response to a show cause order may focus on the evidence previously relied on, as is the case with any request for reconsideration, while offering a better explanation of that evidence or to address a misunderstanding of it. In that case, no new evidence is needed for the Board to withhold judgment against the applicant. Moreover, under Rule 202(d), new evidence may be submitted where "good cause" is shown. As the Court explained in Huston, "good cause" could be shown where the information was not available until after the applicant's initial filing. 973 F.2d at 1566. This might be the case where, for example, tests were being performed and the results were not available until after the original submission, or where with continued diligence the applicant finally locates existing evidence, but only after the initial filing.

Garner's own arguments highlight the flaws in his interpretation. Garner asserts that the Board "blind[ed] itself to the most relevant documents" by declining to consider them. Br. at 29 (emphasis added). But the rule is intended to assure that applicants submit the "most relevant documents" with their initial

filing. And Garner's suggestion that he should be allowed to wait to cite his "most relevant documents" until after the Board issues a show cause order is inconsistent with the purpose of the rule, which was promulgated "to manage a process more efficiently, limit patentee exposure to harassment, and reduce overall pendency of interferences and applications involved in interferences with concomitant patent term extension." JA0010.

Fifth, Garner also argues that because the rules for provoking an interference were amended, the Board's interpretation of the rule is outdated. Br. at 31. However, the substantive requirements prohibiting "new evidence" without "good cause," have not changed, regardless of the language. Thus, the Board's reliance on those prior interpretations is entirely proper.

Sixth, citing the USPTO's notice of rulemaking accompanying the latest version of the rule, he argues that he complied with the requirement that "when the applicant's earliest constructive reduction to practice . . . occurred before the apparent earliest constructive reduction to practice of a targeted patent, it would typically suffice for the applicant to show precisely where its earliest constructive reduction to practice was disclosed." Br. at 21 (citing 68 Fed. Reg. 66648) (emphasis added). The language Garner cites discusses the situation where the applicant has the earliest constructive reduction to practice, the effective filing date of the application is earlier, not the patent. This case is the opposite. Garner, the

junior party applicant in this case, cannot show the “earliest constructive reduction to practice” because Quate’s patent claims priority to an application filed before Garner’s earliest filed application. JA0017. That is why Garner must make a showing of priority. JA0018.

Finally, Garner argues that the Board’s definition of “new evidence” is inconsistent with the manner in which other agencies define that term. Br. at 34-35. The cases Garner cites are inapposite. In Anglin v. West, 203 F.3d 1343, 1345 (Fed. Cir. 2000), the Department of Veterans Affairs was required by statute to reopen a claim when the veteran presented new and material evidence supporting his or her claim. And Haynes v. U.S., 891 F.2d 235, 238 (9th Cir. 1989), stands for the unremarkable proposition that the agency “record” consists of the agency case file. In Garner’s case, there are two separate proceedings with two separate agency files. Specifically, the inter partes interference proceeding is separate from Garner’s ex parte application proceeding, and each has a separate administrative record. Contrary to Garner’s arguments, because the Board considers the evidence properly before it in the interference proceeding, the Board’s rules are compliant with the requirements of the APA.

C. Garner Failed to Establish Priority

In its Order to Show Cause, the Board found that “Garner’s request fail[ed] to provide showings sufficient to establish priority as to the Quate patent.”

JA0140. In its final decision, the Board confirmed that the evidence Garner properly relied on was inadequate to show priority. JAJA0014-25. The Board correctly noted that in his response, “Garner [did] not challenge the findings of the show cause order” that Garner’s evidence was insufficient. JA0007. Now, Garner attempts to show that his initial submission established priority. Br. at 16-20. Because the declarations Garner properly cited to the Board fail to establish that he is entitled to priority, the Board’s judgment on priority is correct.

1. Garner Had the Burden of Proof and Failed to Carry It

In order to establish actual reduction to practice, the inventor must prove that he constructed an embodiment or performed a process that met all the limitations of the claim, and that he determined that the invention would work for its intended purpose. Slip Track Systems, Inc. v. Metal-Lite, Inc., 304 F.3d 1256, 1265 (Fed. Cir. 2002). Determining that the invention will work for its intended purpose may require testing, depending on the character of the invention and the problem that it solves. Id.; see King Instrument Corp. v. Otari Corp., 767 F.2d 853, 861 (Fed. Cir. 1985). To prove reduction to practice by inventor testimony, the inventor’s testimony must be corroborated by independent evidence. Id. As Garner notes in his brief, “the success of the invention [must be] corroborated by an independent observer.” Br. at 16. Garner has failed to present such evidence.

The Board found Garner's 2005 declaration (JA0166-67) insufficient to show priority for two reasons. The Board correctly found that the affidavits and exhibits relied on by Garner did "not show [i)] that the specific elements of the proposed count were present and[, ii)] worked for their intended purpose."

JA0022; see also JA0147-48. To be sufficient, Garner must explain in his declaration "with particularity" the significance of the exhibits relied on. See Hahn, 892 F.2d at 1035. He did not.

First, Garner's declaration does not explain where each limitation of the count is found in the device pictured, or in the lab notebook pages. JA0017-25. The Board noted that the photograph "did not show how each part of the device worked as described in the count." JA0022; JA0025; JA0147. For example, the Board was unable to ascertain from the declaration, not attorney argument, what aspect of the device depicted met all of the limitations of the count described as "a computer controlled micromirror positioned to redirect light from the light source toward the substrate." JA0023. The photograph labeled "Exhibit B" was not even discussed in the 2005 Garner declaration. JA0113-115. In his declaration, there was no discussion of a "DLP" or what one of ordinary skill would have understood that term to mean. JA0023. Thus, the Board was left without a basis to find that the labels attached to the device depicted were accurate or clearly referenced the elements of the count. JA0021-23. But even assuming those labels are accurate,

the Board correctly noted that “nothing [in this picture] is labeled a micromirror of any kind.” JA0148; see also JA0023. There is simply no evidence that the device shown contained all of the components as required by the count.

Nor does the discussion of the lab notebook pages, found in Garner’s 2005 declaration, supply the missing pieces. It does not explain how the actual content of the notebook relates to the device shown in his photograph. JA0148. The notebook does not describe a device matching the count. JA0148.

Second, Garner’s declarations failed to explain how any evidence he relied on showed that the device he allegedly built in August 1997 worked for its intended purpose. Id. With respect to the photograph, Garner’s declarations merely state that the device shown was built and operating in August 1997, but does not explain the operation of the device or that it performed as required by the count. JA0022; JA0147-48; JA0113-14. And even assuming Garner’s photograph of his device showed a “reaction chamber,” the declaration does not establish that “the light redirected by the micromirror catalyzes a chemical reaction proximate the substrate in the reaction,” as required by the count. JA0022-23. The mere presence of components was insufficient to show that those components operated as required in the count. JA0022; JA0147.

Garner’s declaration fails to explain how the lab notebook pages show that the device worked as recited in the count. In the 2005 Garner declaration, Garner

states “[f]rom the lab notebook pages attached hereto as Exhibit A, it can be seen that the invention in this application was used to produce a mask pattern on a substrate on the date even therewith, which is . . . earlier than the effective date of the reference.” JA0166-167. But Garner’s notebook pages do not explain how the device worked. Thus, the Board found Garner’s explanation unhelpful, noting that in the image within the notebook “[o]nly a vague speckled rectangle is visible” and that: “[i]n any event, Garner has not explained what is shown by the ‘mask’ and how it demonstrates that a reaction was catalyzed proximate to the surface of a substrate in the reaction chamber.”⁸ JA0023.

Thus, none of the declarations establish these critical facts necessary to show priority. Garner attempted to fill in the evidentiary gaps in Garner’s declaration with attorney arguments to explain how the device functioned. JA0019-20. The Board rejected Garner’s reliance on attorney argument citing Estee Lauder Inc. v. L’Oreal, S.A., 129 F.3d 588, 595 (Fed. Cir. 1997), for the proposition that attorney argument cannot take the place of evidence lacking in the record. JA0020.

Nor does the Fondon declaration (JA0138) fill the gaps. In it, Fondon merely states that he “saw” the device depicted in the photograph as early as

⁸ The Board noted that even if the declaration Garner filed on March 1, 2001 was “in evidence,” it had the same deficiencies as those found in the 2001 Garner declaration, filed November 28, 2001. JA0020-23. The Board’s comparison of the language of each shows that the March 1, 2001 declaration overlapped that found in the November 18, 2001 declaration, but said less. JA0020-21.

November 1997. JA0024; JA0138. But he does not state or even suggest that he saw the device operate in any manner, much less that it worked in the manner claimed. Fondon does not even describe the various components of the device shown. Because his sworn statement is limited to statements that he merely “saw” the device, that is the only fact the declaration supports. Thus, the Board correctly found that his declaration does not corroborate Garner’s claims that the device included the required components or worked in the manner described in the count. JA0024.

Garner suggests that the examiner accepted the 2001 Garner declaration as establishing priority over other prior art and, thus, it should have been sufficient here. Br. at 8-9. First, Garner offers no citation to the record that supports his argument that the examiner found the 2001 Garner declaration persuasive. Second, the Court rejected a similar argument in Hahn, concluding that only the Board could make a determination of priority, not the examiner handling the junior party’s application. Id. at 1035.

2. Garner’s New Evidence Would Not Have Established a Prima Facie Case of Priority

Even had the Board considered Garner’s 2003 declaration, that declaration has the same deficiencies as Garner’s other declarations: each of the declarations failed to identify all of the components of the count or explain how the device

worked. For example, the Garner declarations do not describe “a computer-controlled micromirror positioned to redirect light from the light source toward the substrate.” JA0022-23. Moreover, those declarations do not explain how “the light redirected by the micromirror catalyzes a chemical reaction proximate the substrate in the reaction,” as required by the count. JA0022-23. And argument from Garner’s attorney cannot fill in the evidentiary gaps in Garner’s declarations. Estee Lauder, 129 F.3d at 595. Thus, assuming the Board should have considered Garner’s 2003 declaration, the Board would have reached the same conclusions.

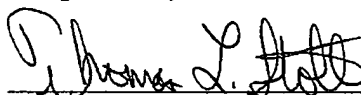
Similarly, Garner’s applications do not cure the evidentiary deficiencies in Garner’s priority showing because in his declarations he failed to explain how that evidence, alone or in combination, meets all of the requirements of the count. Instead, he relied on impermissible attorney argument to fill those gaps. Moreover, it does not appear that the images in the notebook match the images illustrated in Garner’s applications, depriving them of any value they may have had.

VI. CONCLUSION

Because i) the Board's interpretation of Rule 202(d) is correct, ii) the Board properly exercised its discretion in applying the rule to exclude Garner's untimely cited evidence, and iii) Garner has not shown that the Board committed any reversible error in its findings or ultimate conclusion that Garner failed to show actual reduction to practice before the effective filing date of Quate's patent, the decision of the Board should be affirmed.

July 13, 2007

Respectfully submitted,



STEPHEN WALSH
Acting Solicitor

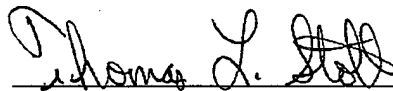
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RULE 32(a)(7)(C) CERTIFICATE OF COMPLIANCE

I certify pursuant to Fed. R. App. Proc. 32(a)(7) that the foregoing BRIEF FOR APPELLEE-DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE complies with the type-volume limitation required by the Court's rule. The total number of words in the foregoing brief, excluding table of contents and table of authorities, is 9,514 words as calculated using the Word[®] software program.

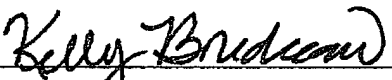
A handwritten signature in black ink, appearing to read "Thomas L. Stoll", is written over a horizontal line.

Thomas L. Stoll
Associate Solicitor

CERTIFICATE OF SERVICE

I certify that on July 13, 2007, I caused two copies of the foregoing
BRIEF FOR APPELLEE-DIRECTOR OF THE UNITED STATES PATENT AND
TRADEMARK OFFICE to be served by Federal Express, overnight delivery,
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